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EXAMINER

SCHNEIDER, CRAIG M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/838,618
Filing Date: April 19, 2001
Appellant(s): HAARALA ET AL.

MAILED
AUG 03 2007
GROUP 3700

Oleg F. Kaplun
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/19/07 appealing from the Office action
mailed 11/14/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct except as noted below.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejection of claims 43 and 44 under 35 U.S.C. 102(b) as being anticipated by Yoon (5,752,970).

Art Unit: 3753

The rejection of claims 43, 44, 46, and 61 under 35 U.S.C. 102(b) as being anticipated by Ferguson (2,063,424).

The rejection of claim 45 under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Engelson et al. (5,798,018).

NEW GROUND(S) OF REJECTION

The rejection of claim 46 under 35 U.S.C. 103(a) as being unpatentable over Eaton (3,303,847) in view of Yamauchi (3,718,140).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,303,847	EATON	9-1963
3,718,140	YAMAUCHI	2-1973
5,789,018	ENGELSON ET AL.	8-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 43, 44 and 61 stand rejected under 35 U.S.C. 102(b) as being anticipated by Eaton (US 3,303,847).

Eaton discloses a medical device having an elongate catheter (5) with an external surface and an internal surface defining an internal lumen and having a compound slit (8, 9) located at a generally hemispherical distal end portion (6) of the catheter and extending from the external surface to the internal surface (see Fig. 4). The slit of Eaton is biased closed and opens due to difference in pressure between the

lumen and the ambient. The slit of Eaton is also configured to inherently allow the flaps to flex into the lumen based on a predetermined pressure difference between the pressure ambient pressure and the pressure inside the lumen and to flex outward when the internal pressure exceeds the external pressure by a second amount.

Claims 43, 44, and 46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi (US 2,063,424).

Yamauchi discloses a medical device having an elongate catheter with an external surface and an internal surface defining an internal lumen and having a compound slit (6) located at a generally hemispherical distal end portion of the catheter and extending from the external surface to the internal surface (see Fig. 3). The slit of Yamauchi is biased closed and opens due to difference in pressure between the lumen and the ambient. The slit of Yamauchi is also configured to inherently allow the flaps to flex into the lumen based on a predetermined pressure difference between ambient pressure and the pressure inside the lumen and to flex outward when the internal pressure exceeds the external pressure by a second amount.

Claim 45 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton in view of Engelson et al. (US Patent Number 5,798,018).

Eaton fails to disclose the collar. Engelson et al. disclose a collar (130) used on a similar catheter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the collar of Engelson et al. with the catheter of Eaton so that the catheter can be radiographed visually as taught by Engelson et al.

Art Unit: 3753

Claim 46 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton in view of Yamauchi.

Eaton fails to disclose wherein the compound slit is a tricuspid slit. Yamauchi discloses the tricuspid slit (Y) in Figure 5 and further the cross-shaped slit in Figure 2 which is equivalent to the slit shown by Eaton.

It would have been obvious to one having ordinary skill in the art to utilize the tricuspid slit of Yamauchi in place of the cross-shaped slit of Eaton since Yamauchi discloses the equivalence of the tricuspid and cross-shaped slits.

(10) Response to Argument

Claims 43, 44, and 61 anticipated by Eaton

Appellant does not appear to understand the Eaton reference. Appellant cites a section that explicitly states that the container is squeezed to increase the fluid pressure and this increase in fluid pressure internal to the catheter causes the slit valve to open. Eaton's disclosure from 1967 clearly anticipates the overly broad claimed subject matter. Regarding claim 61, the appellant is further arguing the functional language that the flaps of Eaton would not flex inwardly if the pressure outside were greater than the pressure inside. The examiner disagrees. The flaps of Eaton would indeed flex inwardly if there was a pressure differential as claimed.

Claims 43, 44, and 46 anticipated by Yamauchi

Appellant argues that the device of Yamauchi does not meet the dictionary definition of catheter. Yamauchi discloses a tubular device that is inserted into a body cavity (mouth) to inject fluids (milk). Appellant argues that babies bite the nipple and do

Art Unit: 3753

not apply any suction. The examiner disagrees. In fact this is explicitly disclosed in the Yamauchi reference (col. 2, lines 61-67).

Claim 45 obvious over Eaton in view of Engelson et al.

Appellant argues the obviousness of Eaton in view of Engelson et al. The appellants' arguments appear to be directed to Eaton only. The rejection of claim 45 would appear to stand or fall with the rejection of claim 43.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

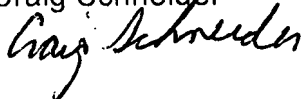
Art Unit: 3753

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

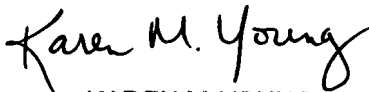
Craig Schneider



ERIC KEASEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Karen Young



KAREN M. YOUNG
DIRECTOR
TECHNOLOGY CENTER 3700

Conferees:

Eric Keasel



Kevin Shaver

